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| 10/574,325 | 04/03/2006 | Michel Basler | 20171 (441 PCT) | 7134 |
| 31743 | 7590 | 06/29/2010 | EXAMINER | |
| Georgia-Pacific LLC 133 Peachtree Street NE - GA030-41 ATLANTA, GA 30303 | | | DUCHENEAUX, FRANK D | |
| | | | ART UNIT | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,325

Applicant(s)

BASLER ET AL.

Examiner

FRANK D. DUCHENEAUX

Art Unit

1787

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2010.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 02 April 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

Examiner's Note

The examiner notes that the substitute specification filed 4/2/2010 has been considered and is entered.

Response to Amendment

1. Applicant's arguments, see pages 6-7, filed 4/2/2010, with respect to the objections of the specification have been fully considered and are persuasive. The objections of the specification have been withdrawn.
2. Applicant's arguments, see page 7, filed 4/2/2010, with respect to the objection of the drawings have been fully considered and are persuasive. The objection of the drawings has been withdrawn.
3. Applicant's arguments, see pages 7-8, filed 4/2/2010, with respect to the rejection of claims 1-12 under 35 U.S.C. 112, 1st paragraph have been fully considered and are persuasive. The rejection of claims 1-12 has been withdrawn.
4. Applicant's arguments, see pages 7-8, filed 4/2/2010, with respect to the rejection of claims 1-12 under 35 U.S.C. 112, 2nd paragraph have been fully considered and are persuasive. The rejection of claims 1-12 has been withdrawn.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 1-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Graff et al. (WO03/050353) in view of Roussel et al. (US 6524683 B1). The examiner notes that the referenced portions of the prior art will be taken from US 2005/0034828 A1, which is an English language equivalent to the ~353 publication.

Regarding claim 1, Graff teaches a multi-layer sheet of absorbent paper (title) comprising a first ply (12) and a second ply (14) each made of tissue paper having a surface weight between 12 and 35 g/m², said first ply including a first embossing pattern which is imprinted in first zones (16) having first protrusions (18) projecting from the inner surface of the first ply and corresponding to alveoles (cavities) on the outer surface with said protrusions' tops (19) (first protuberances)

being linked to the opposite inner surface of the second ply, and further that the first ply includes second embossing pattern constituted of second protrusions (38) (second protuberances) having a height that is shallower than the first protrusions and linked to the inner surface of the second ply (abstract). Graff also teaches that the second protrusions constitute second zones (36), said second protrusions having a height (H2) shallower than the first protrusions (H1) (para 0036, lines 5-8 and figure 2).

It is noted that figure 2 of the reference teaches that the first zones are in relief to the second zones with a level difference of H1 - H2 and that the first and second zones are delimited from each other by a difference in elevation, which constitutes a continuous contour between said zones as currently claimed, while figure 1 of the reference teaches that the first zones (16) are surrounded (adjacent, first zones forming cells) by the second zones (36) as presently claimed. Graff is silent to a continuous contour line completely surrounding the respective first zone.

However, Roussel teaches a sheet of embossed absorbent paper (title) comprising zones G'1, G'2 and salients 210S, said zones and salients are raised in relief to those other portions completely surrounding G'1, G'2 and 210S, which provides an emphasizing effect (column 5, lines 49-65 and figures 3 and 4). It is noted that the raised relief of the said G'1, G'2 and 210S necessarily provides a contour line as presently claimed, which is illustrated in figures 3 and 4 of the reference.

It is significant to note that case law holds that claim limitations relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art (*In re Seid* 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Graff and Roussel references to provide a first and second zone of embossments in a ply, wherein one of the said zones completely surrounds the other of the said zones towards a multilayer sheet of absorbent paper having a distinct ornamental and aesthetic appearance as in the present invention.

Regarding claim 2, Graff teaches that the tops of the first and second protrusions are situated in same plane as the second ply (para 0036, last two lines), which provides the two sets of protrusions with a depth as presently claimed.

Regarding claim 3, figure 1 of Graff teaches non-embossed zones (white areas on the figure) between the second zones (36).

Regarding claims 4-5 and 8, Graff teaches third protrusions in the form of small partitions connect two adjacent first protrusions (para 0019), which provides third embossed zones between second zones as the first zones (16) are surrounded by second zones (36), while figure 5, reference number 30 demonstrates that the third protrusions form continuous lines connecting

the first protrusions generated by embossing tips 28, said third protrusions having a linear shape (see also para 0045).

Regarding claim 6, figure 2 of Graff teaches second protuberances are at least part aligned with the relief demarcation of the first and second zones (at least the leftmost column of second protuberances in the figure).

Regarding claim 7, figure 2 clearly teaches first protuberances having a tapered cross-sectional shape.

Regarding claim 9, figure 2 teaches that 2nd ply (14) is without embossments.

Regarding claims 10-12, Graff is silent to a second ply that is embossed and presents protuberances, whereby the two plies are in contact though the tops of the protuberances corresponding to the second and/or third protuberances, that the plies are bonded though glue on the top of the second and/or third protuberances, or that the first protuberances are not glued.

However, Roussel teaches a sheet of embossed absorbent paper (title) - towards improved pattern resolution and emphasis of a background pattern (column 2, lines 32-34) - of two plies whereby each ply comprises a first embossed zone (column 4, lines 62-63) and two or more adjacent second zones (column 5, lines 49-54) comprising protuberances/salients, whereby the two plies are in contact with each other through the tips of their respective protuberances (figures 1-4 and

claim 3). Roussel continues to teach that the salients (protuberances) coincide perfectly (column 4, lines 54-55 and figure 2)) and that the two plies can be assembled by bonding via gluing or knurling (not glued) (column 3, lines 40-44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Graff and Roussel references to obtain a tissue paper with specific mechanical properties such as bonding strength, absorptivity, and softness as in the present invention as it is well known in the art that adhesively bonding two plies provides increased bonding strength between said plies while glue also diminishes the softness, and further that bonding two plies together via the tips of their protuberances increases a void volume between said plies, which increases the absorbency of a tissue.

Response to Arguments

8. Applicants' arguments, see pages 8-11, filed 4/2/2010 with respect to the rejection of claims 1-9 over Graff et al. under 35 U.S.C. 102(b) and claims 10-12 over Graff et al. in view of Roussel et al. under 35 U.S.C. 103(a) have been fully considered but they are not persuasive.

The applicants have amended claim 1 to further recite that the continuous contour line (D) completely surrounds the respective first zone (A1) and have pointed to figure 1, of which figure 2 provides a cross section, of the present specification in support of said amendment. The applicants submit that the examiner has relied on a "teaching" of Graff rather than a full disclosure in Graff and that the current claim limitation of "delimited by a continuous contour"

was taken out of context by the examiner and equated to groups of second zones (36) of Graff to constitute a continuous contour. The applicants contend that Graff does not disclose a single second zone adjacent to the first in a manner as to form a continuous contour that delimits the first zone.

The applicants' attention is directed to the rejection of claims 1-12 as set forth above where, in light of the applicants' amendments, the rejection of claim 1 is again accomplished via the Graff reference, however, in combination with the Roussel reference. The examiner respectfully notes that it is unclear within the context of the current application precisely what was intended by the applicants in reference to the "teaching" of Graff. The examiner can not fairly rebut the applicants' statement without relying on a subjective interpretation of the applicants' intention, which would be improper.

In regards to the examiner's out-of-context interpretation of the Graff reference, the applicants' attention is directed to the cited figures of the Graff and Roussel references, figure 2 of the present invention and the Merriam-Webster Online Dictionary definition of a contour line, a copy of which is provided with the current action. While neither the current invention nor those of the prior art references are directed to maps, it is clear from the figures of the prior art that the prior art teaches, in light of the current specification, raised elevations of one area, or zone, of embossments relative to another and as such, would naturally provide a contour line between the two zones and delimit said zones from one another as seen from, for example, a plan view of the multiplies of the prior art and current inventions.

In addition, such a contour line delimiting embossed zones, and as can clearly be seen from the prior art figures, would intrinsically provide said zones adjacent to one another, while those raised-in-relief zones of Roussel demonstrate a contour line as discussed above, which is completely surrounding the raised zone. Lastly, it is noted that Graff does indeed illustrate that the zones (16) and (36) are clearly adjacent to one another, while the analogous Roussel reference remedies the deficiency of Graff in regards to the “completely surrounding” limitations and consequently, the combination of Graff in view of Roussel, in light of pertinent case law, teach all the limitations of current claim 1.

The applicants continue to argue (see pages 10-11) that the obviousness rejections are improper given that the prior art references fail to teach and every element of the current invention in such a manner as to perform as the claimed invention performs, and as such, the combination of Graff and Roussel fails to establish a prima facie case of obviousness as Roussel fails to cure the deficiencies of Graff. The applicants further submit that any modification of Graff to arrive at the currently claimed invention would require disassembly and redesign of Graff as Graff does not disclose a second zone working in conjunction with a first zone to form a delimiting contour that completely surrounds said first zone, and that such disassembly and redesign by one of ordinary skill would not be possible without impermissible use of hindsight.

The applicants' attention is directed to the prior art rejections set forth above and the examiner's response to the applicants' arguments against the rejection of current claim 1. The examiner notes that both the prior art references and the current invention are directed towards

absorbent a paper, which would immediately commend to one of ordinary skill that modifications of Graff in view of Roussel would be obvious and thereby arrive at the current invention.

Indeed, as stated above, the currently claimed invention differs from Graff merely in terms of aesthetic design, and there is no salient functional difference between Graff and the instant invention. As such, one of ordinary skill would not have to impermissibly consult the current disclosure in order to be lead from the Graff invention to the current invention, nor would the artisan, upon consultation of the Roussel reference, be unaware or unapprised that a modification of Graff with Roussel would alter Graff in any way other than appearance.

In fact, a relatively recent court ruling upheld the rejection of a patent application over a utility patent combined with design patent. In *In re Fulton*, 391 F.3d 1195, 73 USPQ2d 1141 (Fed. Cir. 2004), the claims of a utility patent application were directed to a shoe sole with increased traction having hexagonal projections in a “facing orientation.” 391 F.3d at 1196-97, 73 USPQ2d at 1142.

The Board combined a design patent having hexagonal projections in a facing orientation with a utility patent having other limitations of the independent claim. 391 F.3d at 1199, 73 USPQ2d at 1144. Applicant argued that the combination was improper because (1) the prior art did not suggest having the hexagonal projections in a facing (as opposed to a “pointing”) orientation was the “most desirable” configuration for the projections, and (2) the prior art “taught away” by showing desirability of the “pointing orientation.” 391 F.3d at 1200-01, 73 USPQ2d at 1145-46. The court stated that “the prior art’s mere disclosure of more than one

alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....”

In affirming the Board’s obviousness rejection, the court held that the prior art as a whole suggested the desirability of the combination of shoe sole limitations claimed, thus providing a motivation to combine, which need not be supported by a finding that the prior art suggested that the combination claimed by the applicant was the preferred, or most desirable combination over the other alternatives.

The examiner notes that the current combination of the prior art references parallels that of the *Fulton* ruling as Roussel demonstrates an available pattern for an absorbent article and, when combined with the analogous Graff reference, remedies the deficiencies of Graff and teaches all the limitations of current claim 1.

Conclusion

9. Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK D. DUCHENEAUX whose telephone number is (571)270-7053. The examiner can normally be reached on M-Th, 7:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie E. Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/FRANK D DUCHENEAUX/
Examiner, Art Unit 1787

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1787